

REMARKS:

Claims 1-28 are currently pending in the application.

Claims 1-28 are hereby canceled herewith, without *prejudice*.

Claims 29-56 are hereby added herewith.

Claims 1-28 stand rejected under 35 U.S.C. § 101.

Claims 1-2, 5-10, 13-18, and 21-25 stand rejected under 35 U.S.C. § 102(e) over U.S. Publication No. 2008/0126265 to Livesay et al. ("*Livesay*").

Applicant notes with thanks the Examiner's response of 14 November 2008. Applicant further notes with thanks the Examiner's withdrawal of the previous rejections of Claims 1-28 under U.S.C. § 103(a) over U.S. Patent No. 6,823,495 to Vedula, et al. ("*Vedula*") in view of the Examiner's Official Notice.

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1-28 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter. Applicant respectfully disagrees.

Applicant respectfully submits that Examiner's rejections of Claims 1-28 under 35 U.S.C. § 101 is moot for at least the reason that Claims 1-28 have been canceled. However, Applicant respectfully submits that newly added Claims 29-56 are in full conformance with 35 U.S.C. § 101.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1-28 stand rejected under 35 U.S.C. § 102(e) over *Livesay*.

Applicant respectfully submits that by canceling *Claims 1-28 Applicant has rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims*. Applicant further respectfully submits that new Claims 29-56 contain unique and novel limitations that are not taught, suggested, or even hinted at in *Livesay*. Applicant believes, however, that the present invention is not disclosed or fairly suggested by *Livesay*, for at least the reasons discussed below.

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Livesay Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 29, this claim recites:

An *electronic commerce system*, comprising:
a *global content directory server* coupled with one or more seller databases over a network, the global content directory server providing a plurality of buyer computers access to the one or more seller databases, the global content directory server comprising:
a storage medium stored therein a schema translation tool comprising:
a storage medium stored therein a *mapping module* configured to:
receive information regarding a source schema and a target schema, the source and target schemas each comprising a taxonomy

comprising a hierarchy of classes into which products are categorized, wherein the target schema comprises a different taxonomy than the taxonomy of the source schema, at least the source schema further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes; and

associate one or more source classes of the source schema with one or more target classes of the target schema; and

a storage medium stored therein an ontology generation module configured to generate a product ontology for each of the target classes based on the product ontologies of the associated source classes.

(Emphasis Added). In addition, *Livesay* fails to disclose each and every element of independent Claims 37, 45, and 53-56.

Applicant respectfully submits that *Livesay* fails to disclose, teach, or suggest Claim 29 elements regarding a “*mapping module*.”

In particular, the Examiner alleges:

a mapping module operable to:

receive information regarding a source schema and a target schema, the source and target schemas each comprising a taxonomy comprising a hierarchy of classes into which products may be categorized,

(FIG. 5 and paragraph [0019], indicate the plurality of schema (XML data files) (buyer and seller) wherein the profile content grouping parameter is (taxonomy hierarchy of classes)).

wherein the target schema comprises a different taxonomy than the taxonomy of the source schema, (Paragraph [0019], indicate the plurality of schema having different profile content (taxonomy data)).

at least the source schema further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes;

(FIG. 5 and paragraph [0019], illustrate the association of the buyer and seller based on profile content (product ontology) parameter (class))

and associate one or more source classes of the source schema with one or more target classes of the target schema;

(paragraph [0019], illustrate the association of the buyer based on a type of service parameter (class) to a seller providing the service or goods)

(14 November 2008 Final Office Action, page 7). (Emphasis Original). By contrast, the cited portion of *Livesay* does not disclose a “*mapping module*”, wherein the “*mapping module*” is

“configured to: *receive information regarding a source schema and a target schema*, the source and target schemas each comprising a taxonomy comprising a hierarchy of classes into which products are categorized, wherein the target schema comprises a different taxonomy than the taxonomy of the source schema, at least the source schema further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes; and *associate one or more source classes of the source schema with one or more target classes of the target schema*,” as recited in Claim 29. (Emphasis added). The question is not simply whether *Livesay* describes a “*mapping module*” but whether *Livesay* describes a “*mapping module*” *configured to receive information regarding a source schema and a target schema and associate one or more source classes of the source schema with one or more target classes of the target schema*, as recited in Claim 29.

Applicant respectfully directs the Examiner’s attention to the cited text of *Livesay*, on which the Examiner relies:

The present invention also preferably utilizes databases of sellers within which profiles have been established to determine which sellers and which either goods or services, or goods and services are to be targeted to the various buyers at any time via a Profile Link. For example, a database on seller XYZ may indicate that XYZ provides goods in categories 1, 2 and 3. When buyer ABC accesses an on-line site or an application wherein goods in category number 2 are utilized, the present invention recognizes that XYZ provides such goods, and provides targeted marketing about XYZ’s capabilities or products to ABC, via a Profile Link, provided with the information page ABC is currently reviewing. The present invention may also recognize that ABC, for whatever reason, does not wish to engage in business with XYZ, or vice versa and thus, does not provide a Profile Link to XYZ’s information. Thus, the present invention utilizes Profile Links to target the marketing of either goods or services, or goods and services to those most likely in need of such goods or services, or goods and services, especially while a buyer is actively pursuing the procurement of such goods or services, or goods and services.

(Paragraph [0019]). However, as noted above, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). As clearly shown in the above-cited portion of *Livesay*, on which the Examiner relies, *Livesay does not expressly describe a “mapping module”* of any kind. The Examiner relies on Fig. 5 and (Paragraph

[0019]) of *Livesay* as evidence that *Livesay* describes the claimed “*mapping module*.” (14 November 2008 Final Office Action, page 7). However, *Applicant can find no express description of a “mapping module”* in Fig. 5 and (Paragraph [0019]) of *Livesay*.

Accordingly, to anticipate Claim 29, *Livesay* must inherently describe the claimed “*mapping module*.”

In that regard, the Examiner states “FIG. 5 and paragraph [0019], indicate the plurality of schema (XML data files) (buyer and seller) wherein the profile content grouping parameter is (taxonomy hierarchy of classes)”. (14 November 2008 Final Office Action, page 7). However, *Livesay* (Column 13, Lines 1-8) *does not say*, as the Examiner appears to be suggesting, that *Livesay receives information regarding a source schema and a target schema and associates one or more source classes of the source schema with one or more target classes of the target schema*.

To the extent the Examiner means to argue that *Livesay might receive information regarding a source schema and a target schema or might associate one or more source classes of the source schema with one or more target classes of the target schema* and that Fig. 5 and (Paragraph [0019]) of *Livesay* would inherently represent a “*mapping module*,” “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-US.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). *Applicant is unable to discern from the passages relied upon by the Examiner* that a “*mapping module*” is necessarily present in *Livesay*. *While it may be possible*, “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Furthermore, as noted above, *the question is not merely whether* *Livesay* describes a “*mapping module*” *but* whether *Livesay* describes a “*mapping module*” *configured to receive information regarding a source schema and a target schema and associate one or more source*

classes of the source schema with one or more target classes of the target schema, as described in Claim 29.

Accordingly, *Livesay* does not inherently describe a “*mapping module*” as defined in Claim 29.

Thus, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of anticipation of Claim 29 under 35 U.S.C. § 102 with respect to *Livesay* because *Livesay* fails to expressly or inherently describe a “*mapping module*”, as claimed in Claim 29. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish Claim 29 from *Livesay*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Livesay*

Applicant respectfully submits that the allegation in the present Office Action that *Livesay* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Livesay* is considered to anticipate all of the elements in Claims 29-56. *A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.* MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of Applicant’s claimed invention is identically shown in *Livesay*. For example, the Examiner asserts that the “*mapping module*”, in Claim 29 is somehow shown in *Livesay*. (14 November 2008 Final Office Action, page 7). Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

Applicant respectfully points out that “it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Applicant respectfully submits that *the Office Action has failed to establish a prima facie case of anticipation in Claims 29-56 under 35 U.S.C. § 102 with respect to Livesay because Livesay fails*

to identically disclose each and every element of Applicant's claimed invention, arranged as they are in Applicant's claims.

Applicant's Claims are Patentable over *Livesay*

Applicant respectfully submits that independent Claim 29 is considered patentably distinguishable over *Livesay*. With respect to independent Claims 37, 45, and 53-56 each of these claims are also considered patentably distinguishable over *Livesay*, for at least the reasons discussed above in connection with independent Claim 29.

Dependent Claims 30-36, 38-44, and 46-52 depend from independent Claims 29, 37, and 45, respectively. As mentioned above, each of independent Claims 29, 37, and 45 are considered patentably distinguishable over *Livesay*. Thus, dependent Claims 30-36, 38-44, and 46-52 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 29-56 are not anticipated by *Livesay*. Applicant further respectfully submits that Claims 29-56 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 29-56 under 35 U.S.C. § 102(e) be reconsidered and that Claims 29-56 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

16 February 2009
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184